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PERKINS COIE, LLP.
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SEATTLE, WA. 98111-1208

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MAR 3 1 2008

OFFICE OF PETITIONS

In re Application of
Yukun Sun et al
Appl. No.: 10/761,717
Filed: January 20, 2004
Attorney Docket No. 57783.8004.US00

:
: DECISION ON PETITION
: UNDER 37 CFR 1.59
:

This is a decision on the petition under 37 CFR 1.59(b), filed June 29, 2007, to expunge information from the above identified application.

The petition is DISMISSED.

On January 31, 2007, the Office received two complete responses to the Office Action mailed July 31, 2006. Petitioner now requests that the first response filed January 31, 2007, be expunged from the record. Petitioner states that this amendment, submitted by Wong, Cabello, Lutsch, Rutherford & Brucculeri, LLP on January 31, 2007, was submitted due to an inadvertent error and was redundant and unnecessary. Petitioner indicates that removal of the first response should not affect further prosecution of the application, and furthermore the second response submitted by Perkins Coie, LLP, constitutes a complete response to the Office Action mailed July 31, 2006.

The petition does not contain a clear statement that the information requested to be expunged is either: (1) a trade secret, proprietary, and/or subject to a protective order; or (2) was unintentionally submitted and failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted.

As explained in MPEP 724.05 a petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that:

- (A) The Office can effect such return prior to the issuance of any patent on the application in issue;
- (B) it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;
- (C) the information has not otherwise been made public;
- (D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
- (E) it is established to the satisfaction of the Director that the information to be returned is not material information under 37 CFR 1.56; and

(F) the petition fee as set forth in 37 CFR 1.17(g) is included.

The petition is deficient with regard to (B), and (C). There is no statement in the petition that the information in the first response would cause irreparable harm to the party who submitted the information.

The statement that the first response was unintentional is insufficient. The Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicants, and that applicant is bound by the consequences of those actions or inactions. These actions or inactions of the attorney/agent must be imputed to the petitioners, who hired the attorney/agent to represent them, Link v. Wabash Railroad Co., 370 U.S. 626, 633-634, 82 S.Ct. 1386, 1390-91 (1962).

The information has been made public. Pending applications that have not been published are generally preserved in confidence. See 37 CFR 1.22(a). A review of the Office records indicates that on July 29, 2004, the application published as US200401046985A1. 37 CFR 1.14(iii) states:

(iii) Published pending applications. A copy of the application-as-filed, the file contents of the application, or a specific document in the file of a pending application that has been published as a patent application publication may be provided to any person upon request, and payment of the appropriate fee set forth in § 1.19(b).

Since the response has been made available to the public, the information submitted, for the above given reasons cannot be expunged. The first response filed January 31, 2007, submitted by Wong, Cabello, Lutsch, Rutherford, & Brucculeri, LLP, will be considered to be applicant's proper response to the Office Action mailed July 31, 2006.

The Extension of Time fee of \$510.00 will be refunded to petitioner's Deposit Account No. 50-2586.

Any renewed petition may be addressed as follows:

By mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By fax: (571) 273-8300
 ATTN: Office of Petitions

By hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this decision should be directed to Thurman K. Page at (571) 272-0602.

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

The application will be forwarded to Technology Center 1600, for actions consistent with this decision.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is written over the printed name.

Anthony Knight
Supervisor
Office of Petitions

I hereby certify that this correspondence is being deposited with the United States Patent Office via EFS-Web Electronic Filing, on:

Date: June 29, 2007

By: /Rena lov/
Rena lov

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

in re Application of: Yukun Sun

Application No.: 10/761,717

Filed: January 20, 2004

For: **METHOD OF PRODUCING INSULINOTROPIC
GLP-1 (7-36) POLYPEPTIDE AND/OR GLP-1
ANALOGS**

Examiner: Liu, Samuel W.

Art Unit: 1656

Conf. No: 3780

PETITION FOR EXPUNGEMENT OF INFORMATION

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants inadvertently filed two responses to the Office Action mailed on July 31, 2006. The first response was submitted by Wong, Cabello, Lutsch, Rutherford & Brucculeri, LLP on January 31, 2007, and the second response was submitted by Perkins Coie LLP. The duplicate response was submitted due to inadvertent error and was redundant and unnecessary. Pursuant to CFR §1.59(b), applicants respectfully request that the first response filed on January 31, 2007 be expunged. Removal of the first response should not affect further prosecution of the application. The second response constitutes a complete reply to the Office Action mailed on July 31, 2006.

Adjustment date: 03/31/2008 CKHLOK
02/06/2007 WASFAW1 00000031 502586 10761717
01 FC:2253 510.00 CR

Applicants further authorize the commissioner to charge \$200 from Deposit Account No. 50-2586 as the expungement fee required under CFR §1.17(g).

Respectfully submitted,

PERKINS COIE LLP

Dated: June 29, 2007

/Zhaohui Wang, Reg. No. 54,674/

Zhaohui Wang

Reg. No. 54,674

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Patent – LA

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Fax: (206) 332-7198

UNITED STATES PATENT & TRADEMARK OFFICE
Washington, D.C. 20231

| REQUEST FOR PATENT FEE REFUND | | | | | |
|-------------------------------------------------------|-----------------------------------|-------------------------------------|-----------------------------|---------------------------------------------------------------------------------------------|-----------|
| 1 Date of Request: <u>03/27/08</u> | | 2 Serial/Patent # <u>10/761,717</u> | | | |
| 3 Please refund the following fee(s): | | 4 PAPER NUMBER | 5 DATE FILED | 6 AMOUNT | |
| | Filing | | | \$ | |
| | Amendment | | | \$ | |
| X | Extension of Time | | 02/05/07 | \$ 510.00 | |
| | Notice of Appeal/Appeal | | | \$ | |
| | Petition | | | \$ | |
| | Issue | | | \$ | |
| | Cert of Correction/Terminal Disc. | | | \$ | |
| | Maintenance | | | \$ | |
| | Assignment | | | \$ | |
| | Other | | | \$ | |
| | | | 7 TOTAL AMOUNT OF REFUND | | \$ 510.00 |
| | | | 8 TO BE REFUNDED BY: | | |
| | | | X | Treasury Check | |
| | | | | Credit Deposit A/C #: | |
| | | | 9 | <div style="border: 1px solid black; display: inline-block; padding: 2px;"> 50--2586 </div> | |
| 10 REASON: | | | | | |
| | Overpayment | | | | |
| X | Duplicate Payment | | | | |
| X | No Fee Due (Explanation): | | | | |
| Duplicate fee paid | | | | | |
| | | | | | |
| | | | | | |
| 11 REFUND REQUESTED BY: | | | | | |
| TYPED/PRINTED NAME: <u>Thurman K. Page</u> | | TITLE: <u>Petitions Examiner</u> | | | |
| SIGNATURE: _____ | | PHONE: <u>272-0602</u> | | | |
| OFFICE: <u>Office of Petitions</u> | | | | | |
| ***** THIS SPACE RESERVED FOR FINANCE USE ONLY: ***** | | | | | |
| APPROVED: <u><i>CKH</i></u> | | DATE: <u>3/31/08</u> | | | |

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